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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,651	04/13/2001	Yasuhiro Nakai	1275-44	1740

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EXAMINER

PILLAI, NAMITHA

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/833,651	Applicant(s) NAKAI ET AL.	
	Examiner Namitha Pillai	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 10 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Appeal Brief

1. In view of the appeal brief filed on 5/19/05, PROSECUTION IS HEREBY REOPENED.

Reasons set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Independent claim 1 is found to have disclosed features that are not taught in Applicant's specifications, wherein claim 1 is treated as containing new matter. Claims 1-8 disclose features that have been previously disclosed in prior art, wherein the previous rejection has been maintained. Claims 9-10 are allowable.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1, as amended on 1/20/04 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The amended claim(s) contains

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subject matter, specifically in reference to the feature of print conditions being displayed on the display picture in a recognizable form “*without having to locate the file icon on the print icon*” which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Since claims 2 and 4-8 depend on claim 1 and include all of the limitations of these claims, claims 2 and 4-8 are rejected under 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 3 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by U. S. Patent No. 5,546,527 (Fitzpatrick et al.), herein referred to as Fitzpatrick.

Referring to claim 3, Fitzpatrick discloses a print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of the file being executed under the predetermined print conditions in the print icon by dragging the file icon and dropping the file icon on the print icon (Figure 4 and column 1, lines 21-30). Fitzpatrick discloses that the print conditions in the print icon are displayed on the display picture in a recognizable display form (Figure 4 and column 2, lines 11-13). Fitzpatrick discloses at a time point a file icon of a file to be printed is superposed on the print icon, a printing preview of the file icon is displayed on the display picture, wherein the print parameters which apply to the file icon for printing inherently

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teaches a preview means for the previewing of the file icon (Figure 4), further as per the present claims, a preview is available of the file icon, wherein the file icon is displayed to the user when the file icon is superposed onto the printer icon as shown in Figure 3, wherein this display of the file icon allows the user to have a print preview of the file icon, wherein the file that is to be printed, is previewed, thus teaching a printing preview of the file icon.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,546,527 (Fitzpatrick et al.), herein referred to as Fitzpatrick and U. S. Patent No. 5,638,505 (Hemenway et al.), herein referred to as Hemenway.

Referring to claim 1, Fitzpatrick discloses a print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of the file being executed under the predetermined print conditions in the print icon by dragging the file icon and dropping the file icon on the print icon (Figure 4 and column 1, lines 21-30). Fitzpatrick discloses that print icon is formed so that the display is altered to a setting of the print conditions, wherein the print icon is formed to have default print conditions (column 1, lines 27-30). Fitzpatrick also discloses the predetermined print conditions in the print icon being displayed on the display picture in a recognizable display form (Figure 4 and column 2, lines 11-13) but discloses that the print

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conditions are displayed by locating the file icon on the print icon. Hemenway carries out the same methods as disclosed by Fitzpatrick of dragging and dropping a file icon on to a print icon in order to print the contents of the file icon (column 1, lines 65-67 and column 2, lines 1-5). Hemenway in addition to that, also displays the print conditions in a recognizable display form without having to locate the file icon on the print icon, wherein this print information is always displayed (reference number 46, Figure 3A). It would have been obvious for one skilled in the art, at the time of the invention to display the print conditions in a recognizable display form without having to locate the file icon on the print icon. Hemenway and Fitzpatrick both teach printing files through icon manipulation, wherein a file icon is dragged and dropped onto a print icon in order for that distinct printer to print the file. Hemenway furthermore allows for the user to view the print conditions without an additional dragging process, wherein this convenient method can be beneficial in Fitzpatrick's disclosure, wherein the user can view the print conditions before dragging the file icon. Furthermore, Fitzpatrick teaches prior art and well known methods in the field of printer processing, wherein the user had access to a printer icon containing printer conditions, wherein a direct access of the user by clicking on this printer icon would allow for the print conditions to be displayed on the display picture in a recognizable display form without having to locate the file icon on the print icon (column 1, lines 35-50). Hemenway further teaches the methods as discussed above.

Referring to claim 2, Fitzpatrick discloses that at a time point when a file icon of a file to be printed is superposed on the print icon, an outline of the print conditions preset in the print icon are displayed on the display picture (Figure 4 and column 2, lines 32-37).

Referring to claim 4, Fitzpatrick does not explicitly imply a plurality of file icons of files to be printed being dragged and dropped on the printer icon. Hemenway much like Fitzpatrick, allows for a drag and drop means for dragging file documents and dropping them onto print icons for printing to occur, wherein Hemenway goes further to display to teach that multiple print jobs are applicable to the one print icon (Figure 5C and column 11, lines 28-31), wherein printer Spitfire discloses having multiple files icons to be printed. It would have been obvious for one skilled in the art, at the time of the invention to learn from Hemenway to implement a means for a plurality of file icons of files to be printed by dragging and dropping the files onto the print icon, thee files being consecutively printed as a series of recorded matters. It is necessary to have a method for printing various documents, which is necessary for users of any computer system. Thus, as Hemenway teaches, the ability to drag and drop a plurality of documents on to the print source or icon allows for the print jobs to be queued to be processed consecutively, thus allowing for various documents to be printed at the same time.

Referring to claim 5, Fitzpatrick discloses when a file icon of a file to be printed is dragged and dropped on the print icon, a window for setting print conditions of the print icon is opened (column 2, lines 47-50 and Figure 4).

Referring to claim 6, Fitzpatrick discloses when a file is dragged and dropped on the print icon, a printer capable of conducting print processing is automatically selected based on print conditions set in the print icon, wherein once the file icon is dropped onto a print icon, from within the parameters disclosed, the specific printer is determined (column 4, lines 1-4).

Referring to claim 7, Fitzpatrick discloses when a file icon is dragged and dropped on the print icon, a printer capable of conducting a print processing is automatically selected from

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among printers in a stand-by state, based on print conditions set is the print icon (column 3, lines 58-60 and column 4, lines 1-4).

Referring to claim 8, Fitzpatrick discloses a printer to be used is set in the print icon as one of set conditions of the print icon (column 4, lines 1-4). Fitzpatrick discloses monitoring the target print icons to determine if the state of the printer is monitored such that the printer cannot execute processing set in the print icon, the print icon is controlled so as not to be displayed (column 6, lines 24-30), wherein Fitzpatrick teaches upon determining that the printer target is cannot do processing will ensure that the print icon is not to be displayed and not accessible for manipulation.

Response to Arguments

6. Applicant's arguments filed 5/19/05 have been fully considered. but arguments related to claims 1, 3 and 8 are not persuasive, whereas arguments related to claim 9 are persuasive.

With respect to Applicant's arguments that Fitzpatrick does not disclose providing a printing preview of the file icon, when the file icon is superposed on the print icon. A printing preview of a file icon is interpreted as a preview of the item that is to be printed, wherien the preview of item to be printed is represented as a file icon. Therefore a disclosure of a printing preview of a file icon is shown in Figure 3, wherien when the user chooses to print document A, the file icon is chosen, and dragged to superpose on the print icon, wherein the user clearly is giving a view or a printing preview of the file icon, where by allowing the user to view the file icon that is to be printed enables the user to have a printing preview of the file icon. The Applicant argues that the features of claim 3 allow the user to view and confirm contents of a file

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to be printed, but the claim does not discuss print previewing of the contents of the file to be printed, but print previewing of the file icon.

With respect to Applicant's arguments that Fitzpatrick and Hemenway do not teach that print conditions are displayed on the display picture in a recognizable form without having to locate the file icon on the print icon. Access to print conditions that are displayed on the display picture without having to locate the file icon on the print icon, is common to the art of print processing, wherein stated in Fitzpatrick. Fitzpatrick teaches that users can directly manipulate and select a printer icon and display recognizable form of the print conditions without the user locating the file icon on the print icon. Furthermore, Hemenway has taught the display of a constant "Print Tool" window that displays printer conditions, without having to locate the file icon on the print icon. The teachings of Fitzpatrick, both Fitzpatrick and Hemenway being print processing systems based on drag and drop of file icons onto print objects, further provides motivation for a proper combination of these prior arts.

With respect to Applicant's argumentst that Fitzpatrick does not disclose that when printer is in a state, wherein not being able to execute a processing set in the print icon, the print icon is controlled so as not to be displayed. Fitzpatrick clearly discloses the step of dealign with target or print icons that are not able to carry out a processing means, and wherein audible means are further carried out to ensure that based on determing that the print icon cannot process, this print icon is controlled to be not displayed (column 6, lines 24-30).

With respect to Applicant's arguments that Fitzpatrick fails to disclose that new print conditions are created when a predetermined plurality of print icons displayed on the display screen and respectively having different print conditions are coupled. Applicant further argues

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that these features are not inherent over Fitzpatrick. These arguments with respect to claim 9 have been fully considered and are persuasive. The U. S. C. 103 (a) rejections of claim 9 have been withdrawn. Similarly since claim 10 depends on claim 9 and include all of the limitations of these claims, the U. S. C. 103 (a) rejections for claim 10 have also been withdrawn.

Allowable Subject Matter

7. Claims 9-10 are allowed.

With respect to claim 9, the prior art, Fitzpatrick teaches displaying a print icon and file icon, the print icon containing predetermined conditions. Fitzpatrick further teaches that print processing of the file to be printed represented by the file icon is carried out by dragging the file icon and dropping the file icon on the print icon. Fitzpatrick also teaches that the predetermined print conditions of the print icon is applied to this print processing of the file. Fitzpatrick teaches creating new print conditions based on user interaction and manipulation of the print and file icons and a further prompt for changing any predetermined parameters. Fitzpatrick and Hemenway do not teach that these new print conditions are created when a predetermined plurality of print icons displayed on the display screen and respectively having different print conditions are coupled. The prior art, in combination does not provide motivation and respectively cannot provide a clear case of obviousness for the distinct features of claim 9, specifically to the creation of new print conditions by the coupling of a predetermined plurality of print icons displayed on the display screen, respectively having different print conditions.

Since claim 10 depends on claim 9 and include all of the limitations of these claims, claim 10 is considered allowable for the reasons in which claim 9 is allowable.

Conclusion

8. Responses to this action should be submitted as per the options cited below: The United States Patent and Trademark Office (Office) requires most patent related correspondence to be: **a)** faxed to the Central FAX number (571-273-8300) (updated as of July 15, 2005), **b)** hand carried or delivered to the Customer Service Window (located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), **c)** mailed to the mailing address set forth in 37 CFR 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or **d)** transmitted to the Office using the Office's Electronic Filing System. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300. Faxes sent to the old number will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery." The official notice dated June 20, 2005 also includes an "updated list of exceptions to the centralized delivery and facsimile transmission policy for patent related correspondence." Questions regarding this notice may be e-mailed to PatentPractice@uspto.gov, or directed to the Inventors' Assistance Center by telephone at 800-786-9199, or 571-272-1000.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namitha Pillai whose telephone number is (571) 272-4054. The examiner can normally be reached on 8:30 AM - 5:30 PM.

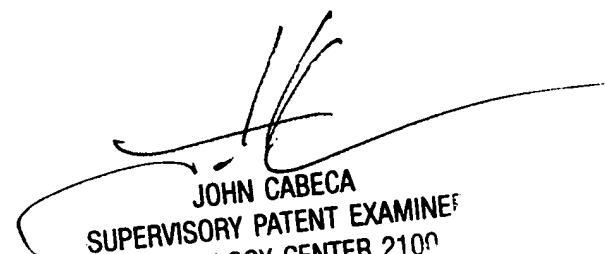
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Namitha Pillai
Assistant Examiner
Art Unit 2173
August 5, 2005


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